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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,313	08/17/2001	Hennie Wesseling	BO 44439 JGD	6559

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YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/856,313	Applicant(s) WESSELING ET AL.	
	Examiner Charlie C. Agwumezie	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3, 4, 6, 9, 10, 12, 13, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone U.S. Patent 5,978,781 in view of Eckert U.S. Patent 4,649,266.

2. As per claims 1 and 10, Sansone discloses a method for checking a franking mark comprising at least an identification code and a unique bit string (see figs. 3 and 4, col. 3 lines 10-15, 40-55), but failed to explicitly disclose a method comprising the following steps:

Reading of the franking mark

Decoding of the franking mark

Checking whether the identification code is correct by comparing it to data in a memory

Checking whether the unique bit string is valid by comparing it to data stored in said memory

Eckert discloses a method for checking a franking mark comprising:

Reading of the franking mark (col. 3, lines 5-15)

Decoding of the franking mark (col. 3, lines 15-25)

Checking whether the identification code is correct by comparing it to data in a memory (col. 3, lines 15-25)

Checking whether the unique bit string is valid by comparing it to data stored in said memory (col. 3, lines 15-25).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Sansone and incorporate the ability to reading of the franking mark and decoding of the franking mark as taught by Eckert in order to further verify and ensure validity of the mail piece.

3. As per claim 3 and 12, Sansone discloses a method in which the franking mark comprises a terminal identification code associated with a terminal which provided the unique bit string to a user (see fig 3 and 4, col. 3, lines 50-55).

4. As per claim 4 and 13, Sansone failed to disclose a method in which the identification code comprises a user identification code and/or a printing identification code, said printing identification code being associated with a printing device which print the franking mark.

Eckert discloses a method in which the identification code comprises a user identification code and/or a printing identification code, said printing identification code being associated with a printing device which print the franking mark (see fig. 1, col. 1, lines 65+).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Sansone and Eckert and incorporate a method in which the identification code comprises a user identification code and/or a

Art Unit: 3621

printing identification code as taught by Eckert in order to further authenticate the mail piece.

5. As per **claim 6 and 15**, Sansone failed to explicitly disclose a method in which the franking mark comprises a combination of the unique bit string and a counter value and the method also comprises the following steps:

f. checking whether said combination occurs in said memory and if so then establishing that the franking mark is valid, and if not, then establishing that the franking mark is invalid.

Eckert discloses a method in which the franking mark comprises a combination of the unique bit string and a counter value (the seed number resident in the decoder and performing a decoding and encryption algorithm with one or more of the parameters e.g. serial number, the date, the piece count etc determines validity of the mark if there is a match) and the method also comprises the following steps:

f. checking whether said combination occurs in said memory and if so then establishing that the franking mark is valid, and if not, then establishing that the franking mark is invalid (col. 3, lines 20-25).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Sansone and incorporate a method in which franking mark comprises a combination of the unique bit string and a counter value as recited in claim 6 and as taught by Eckert in order to further check the validity of the mail piece.

Art Unit: 3621

6. As per claim 9 and 18, Sansone expressly show a method in which the franking mark is located on a postal article but failed to show for the sake of delivery is sorted in at least a first and thereafter a second sorting center, and in which steps a and b are executed in the first sorting center and the information obtained therefrom is sent to a checking center, after which the steps a and b are executed in the checking center prior to sorting in the second sorting center.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The sorted in at least a first and thereafter a second sorting center, would be performed the same regardless since the post office does various sorting depending on the mail piece involved. Thus, this descriptive material will not distinguish the claimed invention from prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the mail will be sorted depending on the mail piece involved because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

7. Claim 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone U.S. Patent 5,978,781 in view of Eckert U.S. Patent 4,649,266 as applied to claim 1 above, and further in view of Cordery et al U.S. Patent 5,982,896.

Art Unit: 3621

8. As per **claim 2 and 11**, Both Sansone and Eckert failed to explicitly disclose a method in which the identification code and the unique bit string are protected with the aid of a Message Authentication Code and /or by means of encoding and the method also comprises the step of checking of the Message Authentication Code and/or the encoding

Cordery et al discloses a method in which the identification code and the unique bit string are protected with the aid of a Message Authentication Code and /or by means of encoding and the method also comprises the step of checking of the Message Authentication Code and/or the encoding (col.2 lines 27-39).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Sansone and Eckert and incorporate a method in which the identification code and the unique bit string are protected with the aid of a Message Authentication Code and /or by means of encoding as taught by Cordery et al in order to further secure and ensure proper validation.

9. **Claim 5 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone U.S. Patent 5,978,781 in view of Eckert U.S. Patent 4,649,266 as applied to claim 1 above, and further in view of Gilham U.S. Patent 6,308,165.

10. As per **claim 5 and 14**, Sansone failed to explicitly disclose a method in which the franking mark comprises a combination of the unique bit string and a counter value, and the method also comprises the following step:

e. subtracting the counter value from the remaining counter value stored with the unique bit string in said memory and checking whether the remaining counter value

Art Unit: 3621

amounts to more than zero, and if so, then establishing that the franking mark is valid, and if not, then establishing that the franking mark is invalid.

Gilham discloses a method in which the franking mark comprises a combination of the unique bit string and a counter value, and the method also comprises the following step:

e. subtracting the counter value from the remaining counter value stored with the unique bit string in said memory and checking whether the remaining counter value amounts to more than zero, and if so, then establishing that the franking mark is valid, and if not, then establishing that the franking mark is invalid (col. 4, lines 7-25).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Sansone and Eckert and incorporate a method in which franking mark comprises a combination of the unique bit string and a counter value as recited in claim 5 and as taught by Gilham in order to further check the validity of the mail piece.

11. **Claim 7 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone U.S. Patent 5,978,781 in view of Eckert U.S. Patent 4,649,266 as applied to claim 1 above, and further in view of Pastor U.S. Patent 5,390,251.

12. As per claim 7, Sansone and Eckert failed to disclose a method in which also is checked whether a period of validity associated with the franking mark has expired.

Pastor discloses a method in which also is checked whether a period of validity associated with the franking mark has expired (col. 4, lines 28-34).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Sansome and Eckert and incorporate a method in which also is checked whether a period of validity associated with the franking mark has expired as taught by Pastor in order to ensure that the mail piece is paid for by the user.

13. **Claim 8**, is rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone U.S. Patent 5,978,781 in view of Eckert U.S. Patent 4,649,266 and Pastor U.S. Patent 5,390,251 as applied to claim 7 above, and further in view of Peyret U.S. Patent 5,688,056.

14. As per **claim 8**, Sansone, Eckert and Pastor failed to explicitly disclose a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark.

Peyret discloses a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark (col. 8, lines 1-7)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Sansome and Eckert and incorporate a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark as taught by Peyret in order to ensure that provider is paid and on time.

Art Unit: 3621

15. **Claim 17**, is rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone U.S. Patent 5,978,781 in view of Eckert U.S. Patent 4,649,266 as applied to claim 1 above, and further in view of Peyret U.S. Patent 5,688,056.

16. As per **claim 17**, Sansone and Eckert failed to explicitly disclose a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark.

Peyret discloses a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark (col. 8, lines 1-7)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Sansome and Eckert and incorporate a method in which, if it is established that the franking mark is valid, a routine is started for automatic post-payment of an account related to the franking mark as taught by Peyret in order to ensure that provider is paid and on time.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited to Pitney Bowes, European Patent Application EP 0 854 444 A2 is a document considered relevant to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is (703) 305-0586. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

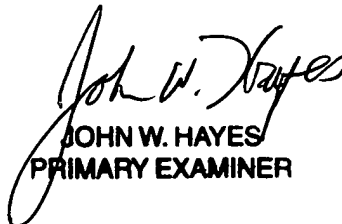
Art Unit: 3621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305 – 9768. The fax phone number for the organization where the application or proceeding is assigned is (703) 305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

acc

November 24, 2004


JOHN W. HAYES
PRIMARY EXAMINER